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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/659,694

09/10/2003

Bob Glickman

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LERNER GREENBERG STEMER LLP  
P O BOX 2480  
HOLLYWOOD, FL 33022-2480

EXAMINER

LIU, CHIA-YI

ART UNIT

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3696

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/659,694	<b>Applicant(s)</b> GLICKMAN, BOB	
	<b>Examiner</b> CHIA-YI LIU	<b>Art Unit</b> 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

This action is in response to an after-RCE election submitted 12/12/2008. Applicant has elected Group II (Claims 8-9) without traverse. After careful consideration of Applicant's arguments, new grounds of rejections for Claims 8-9 are established as set forth in detail below.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mastman (US 2002/0133447 A1) in view of Pritchard (US 2002/0046154 A1), in view of Official Notice, and further in view of Narayan et al (US 2002/0026399 A1) and further in view of Sauter et al. (US 2002/0128947 A1)

As per Claim 8

Mastman ('447) discloses

searching for securities matching the parameters associated with the set of dividend-yielding securities, see paragraph 0016 (searches may be customized by client to use only selected ones of the parameters) and paragraph 0004 (parameters comprises 13) dividend)

weighting the individual securities in accordance with the associated dividend yields, see paragraph 0010, lines 12-16 and paragraph 0004 (parameters comprises 13) dividend)

rating the securities based on an amount of the associated dividend yields, see paragraph 0010, lines 14-16 (parameters produce a rating for each stock) and paragraph 0004 (parameters comprises 13) dividend)

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Mastman ('447) teaches input parameters for a search defining dividend-yielding securities, see paragraph 0004 (parameter 13 = dividend) and that searches may be customized by the client, see paragraph 0016, but fails to explicitly disclose upon receiving an initiation request from a customer, checking a database containing customer information with identification and preferences related to the customer and prompting the customer to select a predefined set of dividend-yielding securities or to input parameters for a new search defining a new set of dividend-yielding securities. Pritchard ('154) teaches indicating identification and preferences related to customer (risk/return preferences indicated by a user) and optimize selection of securities to best meet the preferences of user, see paragraph 0046. Narayan ('399) teaches prompting user to enter specifications (parameters) to the choice of security that should be searched for and server computer stores those specification (parameter) in database, see paragraph 0046. Official Notice is taken that it was old and well known in the art to check a database containing customer information with identification and preferences related to the customer upon receiving an initiation request from a customer. Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Mastman's invention to include upon receiving an initiation request from a customer, checking a database containing customer information with identification and preferences related to the customer and prompting the customer to select a predefined set of dividend-yielding securities or to input parameters for a new search defining a new set of dividend-yielding securities. The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Mastman ('447) teaches weighting the individual securities in the database in accordance with the associated dividend yields, see paragraph 0010, lines 12-16 and paragraph 0004 (parameters comprises 13) dividend), but fails to explicitly disclose weighting securities within the exchange-traded fund. Pritchard ('154) teaches database of investment instruments may contain records of exchanged traded fund, see paragraph 0049 and creating investment trust with a selected investment instrument, see Claim 1 of Pritchard. Since the securities of Mastman are weighted to create a portfolio of securities, it would have been obvious to limit the selection of securities within just one type of investment instrument (exchange-traded fund) as it is taught by Pritchard. The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

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Mastman ('447) teaches placing a plurality of securities in a stock portfolio (establishing a stock portfolio), see paragraph 0002, but fails to explicitly disclose placing a plurality of the securities into the exchange-traded fund and offering for sale shares in the exchange-traded fund. Pritchard ('154) teaches placing a plurality of securities (investment instruments) into an investment trust and trade on an exchange, see paragraph 0056 and that the investment instruments may be exchange-traded fund, see paragraph 0049 and 0045. Sauter ('947) teaches sell exchange-traded shares on the market, see Abstract of Sauter, lines 19-21. Therefore, the Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Mastman's invention to include placing a plurality of the securities into the exchange-traded fund and offering for sale shares in the exchange-traded fund. The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

#### As per Claim 9

Mastman ('447) further discloses searching for a price-earnings ratio associated with the respective securities, see paragraph 0016 (searches may be customized by client to use only selected ones of the parameters) and paragraph 0004 (parameters comprises 5) price earning ratio P/E)

Mastman ('447) teaches weighting the individual securities in the database in accordance with the price earnings ratio and the amount of the associated dividend yields, see paragraph 0010, lines 12-16 and paragraph 0004 (parameters comprises 13) dividend), but fails to explicitly disclose weighting the respective securities in the exchange-traded fund. Pritchard ('154) teaches database of investment instruments may contain records of exchanged traded fund, see paragraph 0049 and creating investment trust with a selected investment instrument, see Claim 1 of Pritchard. Since the securities of Mastman are weighted to create a portfolio of securities, it would have been obvious to limit the selection of securities within just one type of investment instrument (exchange-traded fund) as it is taught by Pritchard. The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHIA-YI LIU whose telephone number is (571)270-1573. The examiner can normally be reached on Mon-Thur alternating Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TOM DIXON can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/THOMAS A DIXON/  
Supervisory Patent Examiner, Art Unit 3696

CHIA-YI LIU  
Examiner  
Art Unit 3696